

REMARKS

Claims 1-8 stand rejected under 35 USC §102(e) as being anticipated by U.S. Patent Publication No. 2003/0220876 to Burger et al. ('Burger').

According to MPEP §2131, "to anticipate a claim, the reference must teach every element of the claim." A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.¹

With respect to independent claim 1, the claim recites elements relating to a "radio frequency reader [being] devoid of a capability to simulate a reader employing reader technology other than radio frequency," in combination with numerous additional elements. The applicants respectfully assert that the Examiner does not even attempt to show that the prior art of record teaches or even suggests the above quoted claim limitation. The applicants further respectfully assert that the Burger reference relied upon by the Examiner for formulating the outstanding anticipation rejection explicitly teaches away from the above quoted claim limitation by reciting that the Burger system includes "one or more commercial card readers 106, one or more commercial bar code readers 107"² in addition to "one or more RFID interrogators 116."³ Thus, Burger at least fails to teach or even suggest an important advantage of the applicants' invention which is reflected by the above quoted claim limitation.

Further with respect to independent claim 1, the claim recites elements relating to "an output device for confirming that a transaction is being performed." The applicants respectfully assert that the Examiner does not even attempt to show that the prior art of record teaches or even suggests the above quoted claim limitation.

Thus, the applicants respectfully submit that the Examiner does not establish that Burger teaches all of the elements of independent claim 1. If the Examiner wishes to maintain the rejection of independent claim 1 over Burger, the Examiner is

¹ *Verdegaal Bros. v. Union Oil of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987)

² U.S. Patent Publication No. 2003/0220876, paragraph [0097]

³ *Id.*

respectfully requested to explain where in Burger there are teachings relating to the “radio frequency reader [being] devoid of a capability to simulate a reader employing reader technology other than radio frequency” and “an output device for confirming that a transaction is being performed,” in the context of the remaining elements of independent claim 1.

Dependent claims 2-7 are believed to be allowable at least for their dependence on an allowable base claim 1, and for additional combination of elements the claims recite.

With respect to independent claim 8, the claim recites elements relating to “a processor module in communication with said memory and said radio frequency reader, said processor module configured by said machine-readable program to attempt to decode said data corresponding to said elicited response,” in combination with numerous additional elements. Relative to the above claim limitation, the Examiner makes a reference to Burger paragraph [0098], accompanying the reference by a comment “via various network capabilities.”⁴ The applicants respectfully assert that the applicants’ most thorough study of the Burger reference in its entirety fails to yield any teaching or even suggestion of decoding a response received from a payment token.

It appears from the above quoted Examiner’s comment that the Examiner, in support of the finding that Burger teaches all the elements of independent claim 8, and particularly those related to the above quoted claim limitation, asserts an inherency argument. The applicants respectfully assert that in order to rely on a theory of inherency, the Examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art.⁵ Furthermore, the fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic.⁶ Moreover, inherency may not

⁴ Office Action of August 6, 2008, page 3

⁵ *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis in original) cited in *MPEP* §2112

⁶ *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993) cited in *MPEP* §2112

be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.⁷

The applicants further respectfully assert that a teaching of a “processor module configured by said machine-readable program to attempt to decode said data corresponding to said elicited response” does not necessarily flow from the teaching of the Burger’s paragraph [0098] which for the convenience of the Examiner is reproduced herein below in its entirety:

[A] network server 114 may form the hub of the network system 100, with each of the interface stations 104, the commercial card readers 106, the commercial bar code readers 107, the RFID interrogators 116, and the computers 108, 110, and 112 being coupled thereto. As discussed in more detail below, the network server 114 may therefore serve as: (1) a repository of information for the network, (2) the entity that controls access to the stored information by the other network devices, and (3) a service provider for financial and non-financial media issuers, advertisers, as well as Pocket Vault holders.

If the Examiner wishes to maintain the rejection of independent claim 8 based on a theory of inherency, the Examiner is respectfully requested to provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art.⁸

Further with respect to independent claim 8, the claim recites elements relating to a “communication module [being] configured to request from [a] remote computer-based apparatus at least one machine-readable instruction for properly configuring said processor module to decode said data . . . responsive to an indication that said processor module is not configured to perform said decoding correctly,” in combination with numerous additional elements. Relative to the above claim limitation, the Examiner makes a reference to Burger paragraph [0098] accompanying the reference by a comment “via a network that controls access to stored information and that also provides service to Pocket Vault holders.”⁹ The applicants respectfully assert that the applicants’ most thorough study of the Burger reference in its entirety fails to yield any

⁷ *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999) (citations omitted) cited in *MPEP* §2112.

⁸ *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis in original) cited in *MPEP* §2112

⁹ Office Action of August 6, 2008, page 3

teaching or even suggestion of requesting from a remote computer machine-readable instructions for configuring a transaction terminal.

It appears from the above quoted Examiner's comment, that the Examiner in support of the finding that Burger teaches all the elements of independent claim 8, and particularly those related to the above quoted claim limitation, asserts an inherency argument. The applicants respectfully assert that a teaching of requesting from a remote computer machine-readable instructions for configuring a transaction terminal does not necessarily flow from the teaching of the Burger's paragraph [0098] which for the convenience of the Examiner is reproduced herein above in its entirety. If the Examiner wishes to maintain the rejection of independent claim 8 based on a theory of inherency, the Examiner is respectfully requested to provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art.¹⁰

Thus, the applicants respectfully submit that the Examiner does not establish that Burger teaches all of the elements of independent claim 8. If the Examiner wishes to maintain the rejection of independent claim 8 over Burger, the Examiner is respectfully requested to explain where in Burger there are teachings relating to "a processor module in communication with said memory and said radio frequency reader, said processor module configured by said machine-readable program to attempt to decode said data corresponding to said elicited response" and "communication module [being] configured to request from [a] remote computer-based apparatus at least one machine-readable instruction for properly configuring said processor module to decode said data . . . responsive to an indication that said processor module is not configured to perform said decoding correctly," in the context of the remaining elements of independent claim 8.

With respect to the claim rejections argued by the applicant herein *supra*, the applicants' selective treatment and emphasis of independent claims of the application should not be taken as an indication that the applicants believe that the Examiner's

¹⁰ *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis in original) cited in *MPEP* §2112

dependent claim rejections are otherwise sufficient. Applicants expressly reserve the right to present arguments traversing the propriety of the dependent claim rejections later in the prosecution of this or another application.

Further with respect to the claim rejections argued by the applicants herein *supra*, while the applicants herein may have highlighted a particular claim element of a claim for purposes of demonstrating insufficiency of the examination on the part of the Examiner, the applicants' highlighting of a particular claim element for such purpose should not be taken to indicate that the applicants have asserted an argument in support of patentability that a particular claim element constitutes the sole basis for patentability out of the context of the various combinations of elements of the claim or claims in which it is present. The applicants maintain the right here forward to assert that each claim is patentable by reason of any patentable combination recited therein.

The Examiner will note that the applicant added new claims 9-20. New claims are believed to be patentable over the prior art of record.

No amendment presented herein contains new matter.

Accordingly, in view of the above amendments and remarks, the applicants believe all of the claims of the present application to be in condition for allowance and respectfully requests reconsideration and passage to allowance of the application.

If the Examiner believes that contact with the applicants' attorney would be advantageous toward the disposition of this case, the Examiner is herein requested to call the applicants' representative at the phone number listed below.

The Commissioner is hereby authorized to charge any additional fees associated with this communication or credit any overpayment to deposit Account No. 50-0289.

Application No. 10/825,088
Amendment dated November 4, 2008
Reply to Office Action of August 6, 2008

Docket No.: H28240

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Respectfully submitted,

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